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HAYNES AND BOONE, LLP  
901 MAIN STREET, SUITE 3100  
DALLAS, TX 75202

EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2645

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/707,987

Applicant(s)

MYERS ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 1-54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi et al. (US 5,848,134) in view of DeSimone et al. (US 6,212,548).

Regarding **claim 1**, Sekiguchi discloses a method for real-time information processing in a multimedia (column 1, lines 8-13), (which reads on claimed “a method of accessing instant messaging from a telephone”) comprising the step of:

presenting to a telephone user (5 on FIG. 1) a subset (column 11, line 36 “now”) of a predetermined user list (column 11, line 36 “the number of users”), the subset representing users (column 11, line 38 “persons”) logged onto a data network (column 11, lines 32-39) [The server outputs the corresponding voice signal telling the numbers of users accessing each meeting room];

responsive to the telephone user selecting a particular user (column 11, line 43 “user A”) from the subset of the predetermined user list (column 11, line 43 “A through C”), sending a message (column 11, line 64 “voice message”) from the telephone user to the selected data network user (column 11, lines 40-65) [The system determines the selection of the user and sends the voice message to the user at the meeting room].

Sekiguchi fails to disclose using an instant messaging protocol.

However, DeSimone teaches an instant messaging protocol (column 4, lines 19-29).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the instant messaging protocol of DeSimone in the invention of Sekiguchi.

The modification of the invention would offer the capability of an instant messaging protocol such as the user would chat in real-time.

Regarding **claims 2 and 35**, Sekiguchi discloses the step of presenting occurs upon receipt of a predetermined command from the telephone user (column 8, lines 40-47).

Regarding **claims 3, 7, 36 and 40**, Sekiguchi discloses the step of presenting includes voice-synthesizing names on the user list (column 11, lines 23-31).

Regarding **claims 4, 9, 37 and 42**, Sekiguchi discloses the step of presenting includes playing back prerecorded names on the user list (column 11, lines 32-39).

Regarding **claims 5, 8, 38 and 41**, Sekiguchi discloses the step of presenting includes displaying names on the user list on a display associated with the telephone (column 5, lines 35-44).

Regarding **claims 6 and 39**, Sekiguchi discloses the step of presenting occurs automatically upon login by the telephone user (column 6, lines 46-54).

Regarding **claims 10 and 43**, Sekiguchi discloses the step of selecting includes the step of receiving a DTMF command from the telephone user (column 11, lines 32-39).

Regarding **claims 11 and 44**, Sekiguchi discloses the step of selecting includes the step of receiving a voice command from the telephone user (column 11, lines 63-65).

Regarding **claims 12 and 45**, Sekiguchi discloses the step of selecting includes the step of receiving a proprietary signal from the telephone (column 6, lines 46-54).

Regarding **claims 13 and 46**, Sekiguchi discloses the step of sending a message includes recording and sending a voice message (column 11, lines 63-65).

Regarding **claims 14 and 47**, Sekiguchi discloses the step of sending a message includes sending a prerecorded voice message (column 11, lines 63-65).

Regarding **claims 15 and 48**, Sekiguchi discloses the step of sending a message includes sending a prerecorded text message (column 13, lines 11-14).

Regarding **claims 16 and 49**, Sekiguchi discloses the step of sending a message includes sending a text transcription of a voice message (column 13, lines 11-14).

Regarding **claims 17 and 50**, Sekiguchi discloses the steps of receiving an instant message in response the message sent by the telephone user and notifying the telephone user of the receipt of the message (column 12, lines 49-62).

Regarding **claims 18 and 51**, Sekiguchi discloses the step of sending a message includes the telephone user's telephone number and a duration of time the telephone user will be available at that number (column 12, lines 6-19).

Regarding **claims 19 and 52**, Sekiguchi and DeSimone as applied to **claims 18 and 50** differ form **claims 19 and 52**. In that it fails to disclose receiving an instant message and notifying the telephone user.

However, DeSimone teaches the steps of, during the duration of time, receiving an instant message in response the message sent by the telephone user and notifying the telephone user of the receipt of the message at the telephone user's telephone number (column 2, lines 13-24).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use receiving an instant message and notifying the telephone user of DeSimone in the invention of Sekiguchi.

The modification of the invention would offer the capability of an instant messaging protocol such as the user would chat in real-time.

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Regarding **claims 20 and 53**, Sekiguchi discloses the step of presenting includes the steps of first determining whether the telephone user is logged onto the data network and if not then presenting the user list (column 6, lines 46-54).

Regarding **claims 21 and 54**, Sekiguchi discloses the step of determining whether the telephone user is logged onto the data network includes determining if the telephone subscriber is a personal communications subscriber and, if the user is, maintaining a presence in the data network for the telephone user for receiving and forwarding instant messages to the telephone user (column 6, lines 46-54).



Regarding **claim 22**, Sekiguchi discloses an apparatus for real-time information processing in a multimedia (column 1, lines 8-13), (which reads on claimed “an apparatus for accessing instant messaging from a telephone”) comprising:

an telephone interface (11 on FIG. 2) for connection to a telephone network (7 on FIG. 1);

an data interface (12 on FIG. 2) for connection to a data network (8 on FIG. 1);  
and

a messaging module (1 on FIG. 1) for presenting a user list (column 11, line 36 “the number of users”) of active data network users (column 11, line 38 “persons”) to a telephone user (5 on FIG. 1) via the telephone interface and responsive to the telephone user selecting a particular user (column 11, line 43 “user A”) from the user list, sending a message (column 11, line 64 “voice message”) from the telephone user to the selected data network user via the data interface (column 11, lines 40-65) [The system determines the selection of the user and sends the voice message to the user at the meeting room].

Sekiguchi fails to disclose using an instant messaging protocol.

However, DeSimone teaches an instant messaging protocol (column 4, lines 19-29).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the instant messaging protocol of DeSimone in the invention of Sekiguchi.

The modification of the invention would offer the capability of an instant messaging protocol such as the user would chat in real-time.

Regarding **claim 23**, Sekiguchi discloses the messaging module includes a call-back feature for notifying the telephone user when an instant messaging reply is received for the telephone user (column 6, lines 46-54).

Regarding **claim 24**, Sekiguchi discloses the data network is a local area network (LAN) (8 on FIG. 1).

Regarding **claim 25**, Sekiguchi discloses the data network is a wide area network (WAN) (7 on FIG. 1).

Regarding **claim 26**, Sekiguchi discloses the data network is an intranet (8 on FIG. 1).

Regarding **claim 27**, Sekiguchi discloses the data network is an Internet (8 on FIG. 1).

Regarding **claim 28**, Sekiguchi discloses the messaging module is a portion of a voice messaging system in the telephone network (7 on FIG. 1).

Regarding **claim 29**, Sekiguchi discloses the messaging module is a portion of a server in the data network (8 on FIG. 1).

Regarding **claim 30**, Sekiguchi discloses the messaging module is a portion of a voice messaging system within a personal computer connected to the data network (2 on FIG. 1).

Regarding **claim 31**, Sekiguchi discloses the messaging module is a portion of a voice messaging system coupled to the telephone network (1 on FIG. 1).

Regarding **claim 32**, Sekiguchi discloses the messaging module is a portion of a telephone network service (7 on FIG. 1).

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Regarding **claim 33**, Sekiguchi discloses a method for real-time information processing in a multimedia (column 1, lines 8-13), (which reads on claimed “a method of accessing instant messaging on the data network at a telephone”) comprising the steps of:

identifying a subscriber (column 11, line 43 “user D”), a telephone number (column 11, line 43 “number”) at which they can receive messages at this number (column 11, lines 40-49) [The system identifies user D and ask the user to select the meeting room];

establishing the user's presence (column 11, line 21) and ability to receive instant messages (column 11, line 24) on the data network (column 11, lines 18-31) [The server determines the number of users accessing the each meeting room];

where an instant message (column 11, line 63 “voice message”) is sent to the subscriber during this period of availability (column 11, lines 63-65), calling the subscriber at the predetermined telephone number (column 12, line 6 “portable telephone”) and delivering the message (column 12, lines 6-19) [The system server sends a message to the portable telephone a procedure message].

Sekiguchi fails to disclose a period of time for which they can receive messages.

However, DeSimone teaches a period of time for which they can receive messages (column 2, lines 13-24).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the period of time for which they can receive messages of DeSimone in the invention of Sekiguchi.

The modification of the invention would offer the capability of a period of time for which they can receive messages such as the user would not be limited to participated only at multiple party chat.

Regarding **claim 34**, Sekiguchi discloses a method for real-time information processing in a multimedia (column 1, lines 8-13), (which reads on claimed "a method of accessing instant messaging on a data network at a telephone") comprising the step of:

identifying a telephone user (column 11, line 43 "user D") as a subscriber (column 11, line 43 "user D"), a telephone number (column 11, line 43 "number") at which they can received messages, for which they can receive messages at this number (column 11, lines 40-49) [The system identifies user D and ask the user to select the meeting room];

establishing the subscriber's presence (column 11, line 21) and ability to receive instant messages (column 11, line 24) on the data network (column 11, lines 18-31) [The server determines the number of users accessing the each meeting room];

presenting to the subscriber a subset (column 11, line 36 "now") of a predetermined user list (column 11, line 36 "the number of users"), the subset representing users (column 11, line 38 "persons") logged onto a data network (column 11, lines 32-39) [The server outputs the corresponding voice signal telling the numbers of users accessing each meeting room];

responsive to the subscriber selecting a particular user (column 11, line 43 "user A") from the subset of the predetermined user list (column 11, line 43 "A through C"),

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sending a message (column 11, line 64 "voice message") from the subscriber to the selected data network user (column 11, lines 40-65) [The system determines the selection of the user and sends the voice message to the user at the meeting room].

Sekiguchi fails to disclose a period of time for which they can receive messages and using an instant messaging protocol.

However, DeSimone teaches a period of time for which they can receive messages (column 2, lines 13-24) and an instant messaging protocol (column 4, lines 19-29).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the period of time for which they can receive messages and using an instant messaging protocol of DeSimone in the invention of Sekiguchi.

The modification of the invention would offer the capability of a period of time for which they can receive messages and using an instant messaging protocol such as the user would chat in real-time.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ng et al. is cited for a method for making a phone call connection over an Internet (FIG. 1).

Sikora et al. is cited for a method for allocating mixed transaction type messages to resources (FIG. 1).

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Bondarenko et al. is cited for a method for providing estimated response-wait-time displays (FIG. 1).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

  
g.g.

November 24, 2002

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

